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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.     |
|---|-------------|----------------------|---------------------|----------------------|
| 10/591,882  | 09/06/2006  | Uwe Skultety-Betz    | 10191/4519          | 6955                 |
| 26646   | 7590        | 09/24/2008           | EXAMINER            |                      |
| KENYON & KENYON LLP<br>ONE BROADWAY<br>NEW YORK, NY 10004 |             |                      |                     | WHITTINGTON, KENNETH |
| ART UNIT  |             | PAPER NUMBER         |                     |                      |
| 2862  |             |                      |                     |                      |
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|   |             |                      | 09/24/2008          | PAPER                |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/591,882             | SKULTETY-BETZ, UWE  |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | KENNETH J. WHITTINGTON | 2862                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 August 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 14-16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 14-26 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 06 September 2006 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1.) Certified copies of the priority documents have been received.  
 2.) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

The Amendment filed August 19, 2008 has been entered and considered.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-16, 18-20, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Garrett (US3662255). Regarding claim 14, Garrett discloses a hand-held locating device for detecting an object enclosed in a medium, comprising:

a housing having an opening penetrating therethrough configured to accommodate a device for marking a surface of the medium (See Garrett FIGS. 1 and 9, item 32 or 32a or 50a, note that openings in the housing can accommodate a marker or pencil or other writing device therein or therethrough);

at least one sensor system positioned in the housing (See FIGS. 1 and 9, item 45 or 45a); and

at least one light source provided in the measuring device configured to illuminate the opening (See FIG. 9, items 200).

Regarding claim 15, Garrett discloses the sensor system has at least one inductive sensor for locating purposes (See FIGS. 1-9, item 45 or 45a).

Regarding claim 16, Garrett discloses the inductive sensor includes a coil, the opening being oriented concentrically in relation to the coil of the inductive sensor (See FIGS. 1-9, note coil 45 or 45a in relation to housing with opening 32 or 32a).

Regarding claim 18, Garrett discloses the opening is formed by a sleeve, the light source configured to illuminate the sleeve (See FIG. 9, note item 50a).

Regarding claim 19, Garrett discloses the sleeve is made of an at least partially transparent plastic (See FIGS. 1-9, item 50 or 50a and see col. 3, lines 31-38).

Regarding claim 20, Garrett discloses the sleeve is configured to scatter light diffusively (See FIGS. 1-9, item 50a, note material is translucent).

Regarding claim 23, Garrett discloses the opening is variably illuminated as a function of a measuring signal of at least one sensor (See col. 7, lines 11-17).

Regarding claim 24, Garrett discloses the light source includes a plurality of light sources (See FIG. 9, note plurality of bulbs 200).

Claims 14 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Engelberg et al. (US2006/0062472), hereinafter Engelberg. Regarding claim 1, Engelberg discloses a hand-held locating device for detecting an object enclosed in a medium (See Engelberg paragraphs 0002-0011, note a vehicle having door handles and steering wheel is hand held and the invention locates objects or people within the medium, i.e., space above or on the vehicle seat surface, inside the vehicle), comprising:

a housing having an opening penetrating therethrough, the opening configured to accommodate a device for marking a surface of the medium (See paragraph 0012, note vehicle as housing with compartment as opening, note also that if the vehicle can accommodate a person, it could accommodate a marker or pencil or other writing device for marking a surface therein);

at least one sensor system positioned in the housing (See paragraphs 0012-0013, note vehicle has temperature sensor within housing); and

at least one light source provided in the measuring device configured to illuminate the opening (See paragraph 0013, note structured lighting can be used to illuminate vehicle for located objects/passengers, note cars have dome lights or other lights for illuminating portions of the interior).

Regarding claim 26, Engelberg discloses a sealing device which allows the opening to be sealed as a function of a measuring signal of at least one sensor (See paragraphs 0012-0013, note windows, i.e., sealing devices, can be closed or opened depending on the temperature readings inside the vehicle compartment).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett in view of Yamashita et al. (US4859931), hereinafter Yamashita. Regarding this claim, Garrett teaches the use of an inductive sensor arrangement, but not including a capacitive sensor. Yamashita teaches using both an inductive sensor and a capacitive sensor in the same device (See Yamashita col. 1, lines 33-65). It would have been obvious at the time the invention was made to incorporate a capacitive sensor into the metal detector of Garrett. One having ordinary skill in the art would do so to locate both metal and non-metallic objects (See Yamashita col. 1, lines 9-13).

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett in view of Audet (US6266006). Regarding these claims, Garrett teaches of the features of claim 14 as discussed above, but not a color coded light signal. Audet teaches an inductive metal/object detector having a light source that is illuminated with a color-coded light signal in at least two different colors (See Audet col. 3, lines 23-35). It would have been obvious at the time the invention was made to incorporate the color coded signal of the detector in Audet in the metal detector of Garrett. One having ordinary skill in the art would do so to provide a definite indication of the presence of an object (See Audet col. 3, lines 23-35).

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett in view of Steber et al. (US6844713), hereinafter Steber. Regarding this claim, Garrett teaches the use of neon lamps for the light source, but not an LED. Steber teaches a

stud finder using LEDs as light sources behind a translucent material (See Steber FIG. 12, note LEDs D2-D5 behind translucent windows 113). It would have been obvious at the time the invention was made to incorporate LEDs in lieu of the neon lamps in the apparatus of Garrett. One having ordinary skill in the art would do so because either can be used to provide a light signal through translucent material as shown in these references.

***Response to Arguments***

Applicant's arguments filed August 19, 2008 have been fully considered but they are not persuasive.

Regarding the rejections of the claims applying Garrett, Applicant initially argues that Garrett does not disclose an opening configured to accommodate a device for marking a surface of the medium. However, as noted above, Garrett discloses an inductor ring assembly with hollow center areas which would allow a marker or pencil or other writing device to fit therethrough (See Garrett FIGS. 1 and 9, item 32 or 32a or 50a). Note also that Applicants submit that the opening in the apparatus of Garrett is too large and cannot provide accurate marking. Accommodate can be defined as "to make room for". Since the inductor assembly of Garrett can make room for a marking device such as a pencil or marker, it accommodates or is configured to accommodate a device for marking.

Applicant then argues that opening in the apparatus of Garrett is relatively large and does not provide any accurate marking. However, the claims do not recite any size or accuracy limitations or any other structural limitations other than the generic accommodation and thus any arguments asserting size or accuracy will be ignored until positively claimed claimed. Nonetheless, the openings in Garrett are sized enough to allow a marker (like a Sharpie) or pencil or other writing device to fit therein. Such a marker or pencil can be used to put a mark on the ground to which the apparatus of Garrett is testing.

Applicant then argues a user would not be able to both hold the device and mark the surface of the medium. However, again, this feature is not claimed and will not be considered until claimed. The claims only require the opening configured to make room for or accommodate a marking device.

Finally, Applicant notes the invention requires a relatively small opening. Again, this feature is not distinguishing because it is not claimed.

For these reasons and those outlined in the rejection above, Garrett discloses an opening configured to make room for or accommodate a device for marking a surface of the medium.

Regarding the rejections of the claims applying Engelberg, it is noted Applicant's broad language allows for the claims to read onto the vehicle of Engelberg and other non-related art devices. Specifically as noted above, the vehicle of Engelberg reads on the invention as claimed in claims 14 and 26.

Applicant initially argues that Engelberg does not disclose or suggest an opening, penetrating through a housing, configured to accommodate a device for marking a surface of the medium. However, as even the title of Engelberg reveals, it is a method for detecting a person in a space, i.e., in a vehicle compartment (See also Engelberg FIG. 3). Thus, the medium would be the interior of the vehicle including the surfaces the vehicle seats wherein the passenger would be seated. Engelberg also discloses a housing, i.e., the vehicle body, which has an opening penetrating through it, i.e., the interior through the windows or the doors of the vehicle provide a penetrating opening. Finally, if a person can be accommodated through the door or even the window of the vehicle and in the vehicle seat (See Engelberg FIG. 3, note person 11), a Sharpie or other marker or pencil or even a can of spray paint can also be accommodated in this opening. Thus, the opening in the vehicle of Engelberg would be “configured to accommodate” or configured to make room for a device for marking.

Applicant then argues that the interior compartment of Engelberg is not penetrating. However, penetrating is a verb that requires a passing through or into. Applicants claimed opening does not pass into the opening, it simply is an opening that exits in the housing, there is no motion through the housing as the term requires. Furthermore, claim 26 recites the housing is sealable, thus the penetrating of the claimed invention is also interpretable as a central opening that is sealable, i.e., not really penetrating. As noted above in the rejection, the vehicle of Engelberg contains an interior compartment and the vehicle is penetrated with this interior compartment

through the doors and windows, which are also capable of being sealed, i.e., closed, in certain circumstances and thus, the vehicle has an opening penetrating the housing.

Applicant next argues that the invention is directed to the location of objects within a medium that is not itself part of the claimed device. However, such feature is also not claimed and thus will not be considered until such is claimed.

Applicants finally argue that Engelberg is directed to a device that is wholly different from the present application. However, it is not the invention disclosed in the application that is being rejected, it is the claimed invention. Applicant's invention as claimed is not distinct from the disclosure of Engelberg and is the reason for the rejections outlined above.

For these reasons Engelberg discloses the features of claims 14 and 26.

For the forgoing reasons, the rejections stand.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH J. WHITTINGTON whose telephone number is (571)272-2264. The examiner can normally be reached on Monday-Friday, 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Assouad can be reached on (571) 272-2210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Kenneth J Whittington/  
Primary Examiner, Art Unit 2862